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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,216	01/02/2004	Philip S. Siegel	067439.0157	1168

5073 7590 11/29/2007

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER	
SHAAWAT, MUSSA A	
ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
11/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

Office Action Summary	Application No.	Applicant(s)	
	10/751,216	SIEGEL, PHILIP S.	
	Examiner	Art Unit	
	Mussa A. Shaawat	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8 and 10-32* is/are pending in the application.

4a) Of the above claim(s) *17-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 7-8, 10-16 and 29-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/07/2007,11/02/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

1. This action is in response to communications filed on 09/07/2007. Claim 12 has been amended. Claims 29-32 have been newly added. Claims 1-5, 7-8, 10-16 and 29-32 are pending examination.

2. IDS submitted on 11/02/2007, and on 09/07/2007 have been considered.

Response to Arguments

3. Applicant's arguments have been fully considered but are not persuasive. In particular the applicant argues, A) Arganbright does not disclose "in response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, and displaying the item to the customer"; B) there is no motivation or suggestion to combine Arganbright in view of Roman.

In response to A), examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Arganbright shows that a customer is presented via a web page i.e. displaying, and selecting at least one item to have it returned or exchanged (see col.63). Furthermore Arganbright discloses a user accessing a link to view order history details i.e. accessing a database for prior purchases made by user (see col.62 lines 43-45). Therefore, Arganbright still meet the scope of limitations as currently claimed.

In response to B) applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be extremely advantageous to incorporate the teachings of Roman into the disclosure of Arganbright, for the same purpose stated in the previous action. Therefore, in view of the above evidence, the combination of Arganbright in view of Roman still meet the scope of the limitations as currently claimed.

Furthermore, KSR forecloses the argument that a ***specific*** teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Double Patenting

5. Claims 1-5,7,8,10-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/817,353 in view of Roman et al and Haseltine '143. Roman et al. and Haseltine disclose obvious variants of the elements recited in claims 1-5,7,8,10-16.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-2, 7-8, 13, 15 and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Arganbright et al, US Patent No. (6,980,962) referred to hereinafter as Arganbright.

Claim 1: Arganbright discloses a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction, (see at least col.62. line 65-col.63 line 10);

In response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, (see col. 63 lines 8-11);

Displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction, (see col.63 lines 5-10);

Receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise having been purchased by the customer in the prior purchase transaction, (see col. 63 lines 8-11);

In response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer, (see col. 63 lines 29-35)

Claim 2: Arganbright teaches wherein the displaying step is performed by displaying a return information web page (see col.63 lines 5-10).

Claim 7/8: Arganbright teaches a method comprising the step of accessing a database to obtain merchant return rules, and displaying at least one of the merchant return rules, (see col.63 1-10).

Claim 13: Arganbright teaches the step of notifying a merchant of the return item, (see col. 63 lines 18-22).

Claim 15: Arganbright disclose downloading the data for printing a return label to the web access tool, (see col.63 lines 30-35).

Claim 30: Arganbright teaches updating a customer profile associated with customer (see col.65 lines 7-10).

Claim 31: Arganbright teaches a method of claim 1, further comprising sending a notification to a merchant associated with a particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise (se col.63 lines 18-22).

Claim 32: the limitations of claim 32 are similar to the limitations of claims 1, and 30-31, therefore claim 32 is rejected based on the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3-5 and 10-12, 14, 16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

RE: Claim 5, Arganbright does not expressly teach accessing a database to obtain customer information about the customer, and wherein the displaying step includes displaying at least part of the customer information. However Roman teaches as evident by Roman accessing a database to obtain customer information about the customer (see pp 0016 line 3), and wherein the displaying step includes displaying at least part of the customer information (Roman disclose the offered replacement product and is read as part of customer information since it will reference the initial product). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to make it convenient for the user or customer to be able to retrieve and view their information.

Re claim 10: Arganbright does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of

determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Re claim 11: Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517.

Claim 12: Arganbright does not expressly teach the step of performing the return is valid is performed by accessing one or more return rules associated with the merchant. However Roman teaches an e-tailer establishes parameter e.g. rules to determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright the motivation being the same as in claim 10.

Claims: 14/16: Arganbright does not expressly teach the step of notifying a merchant of information about the customer, and the step of delivering data about the return to a customer account record. However Roman et al discloses a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged, by the processing center pp0022 line 8).

Claim 3,4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is herby made final.

Claim 29: although Roman et al, in view Arganbright teach a customer returning/exchanging a product and accessing a database to obtain customer information such as name, receipt number, phone number and product description (see Roman et al). Neither Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information.

Examiner takes Official Notice that accessing a database to obtain customer information comprising credit card information or shipping information of a customer is well know and old in the art. It would have been b=obvious to modify the disclosure of Arganbright and Roman et al, to include accessing a database to obtain customer information comprising credit card information or shipping information of a customer, in order to credit the appropriate amount to the customer account or to ship back a defective product for example.

Cited references

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

Contact information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat
Patent Examiner
November 19, 2007

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627